

REMARKS

Applicants have carefully considered the March 25, 2004 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-3 and 6-18 were pending in this application. Claims 8 through 17 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b).

In response to the Office Action dated March 25, 2004, claim 7 has been canceled and claims 1 and 18 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-3, 6, 7, and 18 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Lee et al. (U.S. Pat. No. 5,223,447, hereinafter "Lee"). In the statement of the rejection, the Examiner referred to Fig. 3 asserting the disclosure of a semiconductor device comprising a trench isolation corresponding to that claimed. Applicants respectfully traverse

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in

imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the device disclosed by Lee that would preclude the factual determination that Lee identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Applicants respectfully submit that the trench isolation disclosed by Lee is not substantially embedded with an insulator, but rather, Lee discloses an isolation merged trench which is made to increase the area efficiency of a storing capacitor by utilizing both surfaces of a storing electrode within the trench as a capacitor. See Lee at col. 2, lines 30-36; and col. 2, line 64 through col. 3, line 9. The interior of Lee's trench is embedded with  $n^+$  doped polysilicon regions 25, 41. See Lee at col. 3, lines 60-68. Accordingly, Lee fails to identically disclose each feature of independent claims 1 and 18 and, therefore the rejection under 35 U.S.C. §102 for lack of novelty as evidenced by Lee is not legally viable and should be withdrawn.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

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extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Brian K. Seidleck". The signature is fluid and cursive, with the first name "Brian" and last name "Seidleck" clearly distinguishable.

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